

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  UNAX1-38300									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/540,162	Filed  December 23, 2005									
	First Named Inventor  Andreas Schuetze										
	Art Unit  1795	Examiner  Michael A. Band									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px;">/michaelwgarvey/ _____ Signature</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px;">Michael W. Garvey _____ Typed or printed name</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35878</u></td><td style="vertical-align: top; padding: 5px;">216-579-1700 _____ Telephone number</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding: 5px;">February 19, 2010 _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/michaelwgarvey/ _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Michael W. Garvey _____ Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35878</u>	216-579-1700 _____ Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	February 19, 2010 _____ Date
<input type="checkbox"/> applicant/inventor.	/michaelwgarvey/ _____ Signature										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Michael W. Garvey _____ Typed or printed name										
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35878</u>	216-579-1700 _____ Telephone number										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	February 19, 2010 _____ Date										
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/540,162  
Applicant : Andreas Schuetze et al.  
Filed : December 23, 2005  
TC/A.U. : 1795  
Examiner : Michael A. Band  
Title : VACUUM ARC SOURCE WITH DEVICE FOR PRODUCING A  
MAGNETIC FIELD

Confirmation No. : 3597  
Docket No. : UNAX1-38300  
Customer No. : 00116

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicants request review of the final rejection in the above-identified application pursuant to 1296 Off. Gaz. Pat. Office 67 (July 12, 2005) and 1303 Off. Gaz. Pat. Office 21 (February 7, 2006).

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal pursuant to 37 CFR § 41.31(a)(1), accompanied by the requisite fee of \$540.00 under 37 CFR § 41.20(b)(1). Please also charge \$970 for the three month extension of time fee to Deposit Account 160820, Order No. UNAX1-38300. Please be advised that the three month extension of time fee is \$1100 but we have previously paid \$130.

The review is requested for the reasons stated on the following sheets.

## **REASONS FOR REQUEST**

### **1. Background**

Claims 1-7, 15, and 33-34 were rejected under 35 U.S.C. 102(e) as being anticipated by Larrinaga (U.S. Pat. Pub. 2004/0112736), equivalent to Goikoetxea et al. (WO 02/077318). Furthermore, the Examiner has alleged that the proposed amendment to claim 1 filed after a final rejection introduces new matter and, therefore, will not be entered.

### **2. Omission of Elements Needed for a *Prima Facie* Rejection**

Claim 1 states “said device for producing the magnetic field comprising at least two magnet systems with opposite poles.” Larrinaga does not disclose this claim limitation. The Examiner has alleged that Larrinaga teaches a target (2) in an effective area of a device comprising two magnet systems (3) – (5) with opposite poles. Applicants respectfully disagree.

Larrinaga teaches a group of permanent magnets (3) and a second magnetic system constituted by a single electromagnet (4-5) located behind a target (2). As is shown in FIG. 1, the magnet systems (3, 4-5) all have the same orientation. That is, the north poles all face in the same direction. The north poles of both magnet systems (3, 4-5) are oriented towards the substrate (10). Thus, the magnet systems (3, 4-5), do not have “opposite poles” as claimed.

In distinction, claim 1 requires “at least two magnet systems with opposite poles.” The magnet poles in Larrinaga are not opposite; they all face the same direction. Furthermore, the Examiner does not explain how Larrinaga meets this limitation, but instead merely states that Larrinaga has “two magnet systems [3]-[5] with opposite poles.” Presumably, the Examiner relies on the fact that each magnet has opposite north and south poles. It is understood, however, that every magnet system has two opposite poles, both a north pole and a south pole. One skilled

in the art would not interpret the phrase “at least two magnet systems with opposite poles” to refer to the two poles of the same magnet, the north and south poles. Rather, the phrase would be understood to refer to the orientation of the poles of one magnet system relative to the other magnet system, such as magnet systems with poles facing the same direction versus magnet systems with poles oppositely oriented (i.e., facing opposite directions). Therefore, Larrinaga teaches magnet systems with poles oriented in the same direction, and not “magnet systems with opposite poles,” as recited in claim 1. Accordingly, claim 1 is believed to be in condition for allowance. Applicants respectfully request withdrawal of the corresponding rejection of claim 1.

Claims 2-16, and 33-34 depend from independent claim 1 that is believed to be in condition for allowance as set forth above. Accordingly, applicants respectfully request withdrawal of the corresponding rejection of claims 2-16 and 33-34 as depending directly or indirectly from allowable claim 1.

### **3. Support for the After Final Amendment is Found in the Disclosure**

In a response to a final Office action, applicants attempted to amend claim 1 to state “device for producing the magnetic field comprising at least two magnet systems with oppositely oriented poles” to make the distinction noted above even more explicit. The proposed amendment was not entered, however, because the Examiner alleged that it raised the issue of new matter. An interview with the Examiner confirmed that the Examiner did not merely consider this a new issue that could be addressed by filing an RCE. Rather, the Examiner contended that the amendment attempted to enter new matter. So, even filing the amendment with an RCE would prompt a new matter rejection. Applicants assert, however, that the claimed structure is adequately supported by the disclosure.

An example of the magnets according to the invention is shown in FIG. 1 in which two magnet systems 9, 10 are positioned behind a target 6. As described on page 7 of the specification, “the two coils are connected to the line devices so that the currents flowing through the two coils run in opposite directions electronically.” Having the two coils run in opposite directions has the effect of making the poles oppositely oriented. Moreover, as described in the final paragraph on page 4 of the specification describes the placement of a second coil placed behind the first magnet system. The second magnet system is “oriented against the effect of the first magnet system” and “the opposite parallel components of the two magnet systems, depending on their distance from the target, cancel each other out in part or in full.”

As stated above, one skilled in the art would not understand “two oppositely oriented poles” to refer to the two poles of the same magnet. Moreover, one skilled in the art would understand the phrase on page 3 “...that includes at least two magnet systems with opposite poles” to mean “oppositely oriented.” Lastly, applicants point to the phrase on the bottom of page 8, stating “magnets with an identical pole orientation are placed on the back of the target near the rim, and one or more magnets with opposite poles stands opposite them in the center of the target...” Here, identical pole orientation is put in relation to opposite poles, i.e., opposite pole orientation, as would be known by one skilled in the art.

Consequently, the proposed amendment to claim 1, “the magnetic field comprising at least two magnet systems with oppositely oriented poles...” is supported by the application as filed. Applicants respectfully assert that the amendment does not raise the issue of new matter.

#### **4. Omission of Elements Needed for a *Prima Facie* Rejection**

The cited reference, Larrinaga, does not disclose the limitations in the proposed amendment of claim 1. As stated above, Larrinaga teaches a group of permanent magnets (3) and a second magnet system constituted by a single electromagnet (4-5) having the same orientation with the north and south poles facing in the same direction. Both the north poles of the magnet systems (3, 5) are oriented towards the substrate (10). Thus, the poles are not “oppositely oriented,” as claimed. Therefore, the proposed amendment to claim 1 is not anticipated by Larrinaga.

#### **4. Conclusion**

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 16-0820, our Order No. UNAX1-38300.

Respectfully submitted,  
PEARNE & GORDON LLP

Date: February 19, 2010

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